



UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of Prodromos Pericles Stephanos) Date: March 14, 2003
Application No. 09/756,597) Group Art Unit: 1714
Filed: January 5, 2001) Examiner: Cephia Toomer
For: Lighter Fluid Composition) Attorney Ref. No.: 130.01

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Reply to Office Action

The applicant, Prodromos Pericles Stephanos, respectfully responds to the rejection issued on September 17, 2002. In support of this response, the applicant also submits a new declaration, which accompanies this response.

Introduction

The present invention is a novel lighter fluid, with two distinctive attributes. First, instead of petrochemical distillates, it relies on terpenes or terpenoid oils together with a short chain alcohol for combustion. Second, it has thickening agents which cause the composition to gel, thereby yielding a number of unexpected advantages.

No single reference reveals both these attributes, but the examiner has rejected the application based on a combination of two earlier patents: the Wilkins patent (U.S. patent no. 5,252,107), and the Wesley patent (US 5,773, 706). The examiner has concluded that Wilkins provides the terpene plus alcohol component of the present invention, while Wesley can provide the thickening agent.

However, as explained below, the prior art provides no motivation to combine these references. Neither Wesley, nor Wilkins, nor any other cited prior art suggests that terpene-based lighter fluids should be gelled and placed in an emulsion to achieve the unique advantages of the present invention.

Additionally, the applicant offers *new* evidence showing that the invention has enjoyed great commercial success, including a license to Duraflame, and acceptance by major

allowance issued.

No Motivation Has Been Shown to Combine the Wilkins and Wesley References

It is improper to combine references unless there is "some teaching, suggestion or incentive supporting the combination." *In re Geiger*, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). The examiner bears the burden of explaining the motivation:

When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper . . . [a]bsent such reasons or incentives, the teachings of the references are not combinable.

Ex Parte Skinner, 2 U.S.P.Q. 2d 1788, 1790 (B.P.A.I. 1987).

Here, there is no reason to combine Wesley with Wilkins, given the objectives of the present invention.

When he started working on his invention, the applicant's main goal was to produce a lighter fluid that would be "environmentally-friendly" and that would have lower emissions of volatile organic compounds (VOCs) than traditional fluids. *See* Stephanos Declaration ¶ 4. A secondary goal was to develop a fluid that had a pleasant smell. *Id.* The applicant discovered, through extensive trial and error, that gelling decreases VOC emissions for a number of reasons. *See* Stephanos Decl. ¶¶ 6-15. These reasons include (i) reduced "boiling off" off unused fluid since the gel does not significantly soak into the coals, (ii) lower evaporation rate, (iii) longer burn time, resulting in the need for less fluid and in more efficient burning of the fluid that is used, and (iv) less wasted fluid, because consumers can see where and how much they are applying. *Id.*

Nothing in Wesley -- or any other cited reference for that matter -- suggests that gelling would accomplish these goals, or would do *anything* to lower VOCs. Wesley *does* provide reasons for gelling, but these reasons have nothing to do with lowering VOCs or making a nice smell. Put simply: an inventor trying to

Indeed, the purpose of the Wesley invention is not to lower emissions, but instead its purpose is to make it easier to transport the fluid because it can be classified as a solid. Col. 1, 51 - 54. A secondary purpose of Wesley's invention is to make it easier for organic fluids to stick to vertical surfaces, but this rationale is inapplicable here because the present invention is meant to be applied *underneath* the charcoals. Col 1, lines 18 - 22; Stephanos Declaration ¶ 19 and Exhibit B. Wesley also makes a passing reference to lower evaporation rates, but this characteristic is never linked to VOC emissions. Col 1, lines 26 - 29.

Wesley also does not suggest that gelling would further any of the other advantages of the present invention, including a longer burn time, a pleasant smell, and lower manufacturing costs. *See* Stephanos Decl. ¶¶ 16 -20. Wesley might be helpful to an inventor who wants to ship his or her lighter fluid as a solid, but it has no relevant teachings to an inventor who wants to create a lighter fluid with the advantages of the present invention.

Thus, it would have been far from obvious for an inventor trying to lower VOCs to look to the teachings of Wesley. *Smith Industries Medical Systems Inc. v. Vital Signs Inc.*, 51 U.S.P.Q. 2d 1415, 1421 (Fed. Cir. 1999). Only by using impermissible hindsight is possible to combine these references to support a 35 U.S.C. 103 rejection. The present rejection is based on just the sort of "hindsight reconstruction" that the Federal Circuit has condemned:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that 'one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'

In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

Thus, the applicant respectfully requests that all claims of the present application are not

The Invention's Commercial Success Proves That It Is Not Obvious

The applicant has new evidence that the present invention has enjoyed a great degree of commercial success, thereby undermining the claim of obviousness. *See* Stephanos Decl. 21 -26.

First, the applicant's product has been licensed to Duraflame, a major hearth and barbecue company. *See* Stephanos Decl. ¶ 22. A company like Duraflame would not license a product that is merely an obvious variant of existing technology.

Second, the invention is on retail shelves under the product name "Fresh Light" throughout the country, at the following major stores, as well as others:

1. Safeway
2. Albertsons
3. Bashas
4. C&S Wholesale
5. Fleming
6. Orchard Supply
7. Sears Hardware
8. Publix Supermarkets.
9. Ralphs Grocery
10. Randalls
11. Stater Brothers
12. Tom Thumb
13. Unified Western Grocers
14. Vons
15. Winn Dixie
16. Piggly Wiggly
17. Krogers
18. Dominiks
19. Nob Hill
20. Cala Foods

See *Stephanos Decl.* ¶ 23.

In its first year, "Fresh Light" sold more than 250,000 units, which means that it went from a complete unknown to a well-accepted product within a single year. *Id.* Industry insiders have opined that this product will achieve tremendous market share and recognition due to its unique qualities. *Id.*

This commercial success is especially remarkable because the inventor had no previous experience creating lighter fluids. *Id.*; see *Pro Mold and Tool Co. v. Great Lakes Plastics Inc.*, 37 U.S.P.Q.2d 1626, 1630 (Fed. Cir. 1996) (applicant's "lack of previous experience in the relevant market combined with its high sales of the patented product provide an inference of a nexus between its commercial success and the patented invention and thus [is] probative evidence of nonobviousness").

This success is a direct result of the claimed invention, since the commercially successful "Fresh Light" product is nothing other than an embodiment of the present invention -- Fresh Light *is* the applicant's invention. *Stephanos Decl.* ¶ 24. Moreover, this success cannot be attributed to clever advertising, since Fresh Light has not been the subject of any advertising, other than some coupons. *Stephanos Decl.* ¶ 25. Instead, Fresh Light's success clearly results from the advantages of the applicant's new composition. If Fresh Light was just an obvious modification of existing technology, it would not have penetrated the market so quickly and broadly.

Conclusion

For the reasons stated above, the present application should be granted.

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